UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,294	10/15/2004	Klaus Lenhart	Q98835	2233

23373 7590 12/23/2008

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER	
GARCIA, ERNESTO	

ART UNIT	PAPER NUMBER
3679	

MAIL DATE	DELIVERY MODE
12/23/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/511,294	LENHART, KLAUS	
	Examiner	Art Unit	
	ERNESTO GARCIA	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 November 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8-16,21 and 23* is/are pending in the application.

4a) Of the above claim(s) *13,14,21 and 23* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-12,15 and 16* is/are rejected.

7)☒ Claim(s) *11* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 November 2008* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 10, 2008 has been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

The instruction to replace paragraph [021] on the specification has been amended as the substitute specification filed on November 16, 2007 does not have paragraph numbering. Further, the reference to the "first full paragraph" is incorrect because this paragraph, with respect to the substitute specification, is actually the second full paragraph. The examiner has amended the instruction to the amended paragraph.

Interview

The examiner regrets to inform applicant that the language "and contactable with each limit stop" presented at the interview, which persuaded the examiner, and not taught by Lenhart, does not appear to be supported by the original disclosure as the fins in the instant application do not engage the cylindrical shoulder 38 so that the spreadable element moves with or becomes dragged with the fins thus allowing the spreadable element to make contact with the lower limit stop as compared to the model presented. The examiner realized, after the interview, that the fins on the model where much longer in the radial direction than shown and abutted the cylindrical shoulder 38 thus allowing the spreadable element to move with the fins and being dragged so that the spreadable element contacts the lower limit stop. The fins on the model that permit the spreadable element to move to the lower limit stop are not in the original disclosure. The fins in the model are much longer than the inner diameter of the cylindrical shoulder 38 as compared to the original drawings filed. This feature is the difference between the model and that disclosed. Since the fins do not engage with the cylindrical shoulder in the instant application, the spreadable element does not move or contact with the lower limit. To allow the spreadable element to contact with the lower limit would require the fins engaging at the top edge of the cylindrical shoulder 38 as presented in the model.

Election of Species

Claims 13, 14, 21, and 23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 20, 2006.

Regarding the withdrawal of claims 21 and 23, these claims are not readable on the elected species I, Figures 1 and 2, as the axial slots 43, 44 do not extend an entire axial length of the radially spreadable element 16. The slots 43, 44 rather stop short of the entire length at the cylindrical shoulder 38. These claims also do not read on the non-elected species as the non-elected species only has one axial slot that extends an entire axial length of the radially spreadable element and an axial slot that extends up to the slotted cylindrical shoulder 138.

Drawings

The drawings were received on November 10, 2008. These drawings are accepted.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-11, 15, and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 8 and 10, the recitation "and is contactable with each limit stop" in claims 8 and 10, lines 15-16, is not supported by the written description requirement and neither is this limitation shown in elected Figures 1 and 2. The affidavit indicates that Figure 1 shows contact with contact of shoulder 38 of element 16 at page 3 but this is not accurate as Figure 1 only shows contact with stop 26 as described on page 6, lines 20-25. This passage which is paragraph [030] in the PGpub does not mention any reference to shoulder 38. Applicant further remarks on page 3 that the shoulder of element 16 with stop 28 occurs due to axial force as explained in [030]. This is also inaccurate as no reference to stop 28 to axial force is disclosed. The examiner acknowledges that there is an axial force due to the push as described on [030] but this is only in reference to the contact to stop 26 as shown in Figure 1 and not stop 28.

The other end of the pot base is spaced away from the shoulder 38 by a gap **a**. Furthermore, the drawings and the specification do not show how this is done or for that matter how the spreadable element moves to the left side of Figure 1 into the gap **a** and past the gap **a** so that the spreadable element contacts the limit 28 stop disposed at the end of the inner tube. Accordingly, the spreadable element does not contact the limit stop 28 and neither the specification explains how the spreadable element moves to contact the limit stop 28 at the end of the inner tube. This is a new matter rejection.

Regarding claims 8, 10, 15, and 16, the recitation "including a gap distance" in claims 8, 10, 15, and 16, line 15, is not supported by the written description requirement. The specification does not have support for the spreadable element being moveable within the gap distance **a** shown in Figure 1. According to the original specification at page 6, line 28, it describes a slight distance **a** with respect to an inner limit stop surface 38, but this does not imply or state that the spreading element moves in this distance, which has been equated to the gap as claimed. Furthermore, the drawings and the specification do not show how this is done or for that matter how the spreadable element moves to the left side of Figure 1 into the gap **a**. Accordingly, this is a new matter rejection.

Regarding claims 9-12, the claims depend from claim 8 and therefore contain new matter.

Claims 8-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 8 and 10, the recitation “and is contactable with each limit stop” in lines 15-16 makes unclear how the spreadable element makes contact with the limit stop at the end of the inner tube. What mechanism allows the spreadable element to move towards the limit stop at the end of the inner tube. The drawings merely show the inner taper of the interior element 17 moving toward the limit stop at the adjusting screw due to the thread moving the interior element, as in a power screw. As a result it pushes the spreadable element towards the interior element. However, this would only move the spreadable element toward the limit stop at the end of the screw. Note that there's nothing in the specification or for that matter in the drawings that show how the spreadable element moves back. If one were to remove the inner element from the outer cone, the spreadable element will still remain in place as the corresponding tapers merely disengage. There’s nothing in the drawings that indicates how the spreadable element moves towards the limit stop at the end of the inner tube.

Claim Rejections - 35 USC § 103

Claims 8, 9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lenhart, DE-29,706,849, in view of Neuheiten, CH-267,177.

Regarding claim 8, Lenhart discloses, in Figures 1 and 5, an adjustable-length pole comprising at least one outer tube **12**, an inner tube **11** structured, an adjusting screw **118'**, a radially spreadable element **116**, and an axially moveable interior element **117**. The inner tube **11** is dimensioned for insertion into the outer tube **12** in a telescoping fashion. A limit stop **19** is disposed at an end **13** of the inner tube **11**. The adjusting screw **118'** is axially oriented within the outer tube **12**, non-rotatable with respect to the inner tube **11**, and supported in a fixed manner on the end of the inner tube **11**. A limit stop **126** is disposed on the free end of the adjusting screw **118'**. The spreadable element **116** has a non-threaded bore **A1** (see marked-up attachment provided in the last Office action) and an inner cone **122'**. The inner cone **122'** opens towards the end of the inner tube **11**. The spreadable element **116** is disposed with its axial length between the limit stop **19** disposed at the end of the inner tube **11** and the limit stop **126** disposed on the free end of the adjusting screw **118**'. A distance **A2** between the limit stops **19**, **126** is larger than the axial length of the radially spreadable element **116** by a gap distance **A3** such that the spreadable element **116** is able to move axially within the distance between the limit stops including the gap distance **A3**. The spreadable element **116** is able to contact the limit stop disposed on the free end of

the adjusting screw **118**'. The interior element **117** has an internal threaded bore **A4** (note that the interior element is threaded as that shown in DSI, DE-8,004,343) and outer cone **127'** structured, dimensioned, and disposed for cooperation with the inner cone **122'**. The interior element **117** is screwed onto the adjusting screw **118'** and able to axially move with respect to the inner tube 11 by rotation thereof via the internal threaded bore **A4**. The spreadable element **116** and the interior element **117** cooperate and form a spreading device axially supported at the end of the inner tube **11**. However, Lenhart fails to disclose the inner cone **122**' being only one single inner cone of the spreadable element since spreadable element has two inner cones. Neuheiten teaches, between Figures 5 and 6, that a spreading element can have one inner cone or two inner cones as similarly taught in Lenhart. Neuheiten teaches alternative configurations in order to minimize parts so that the lower cone only holds (see machine translation provided in the last Office action). Therefore, as taught by Neuheiten, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the inner cone **122**' of Lenhart be the only one single inner cone to minimize the number of parts as an alternative configuration so that the lower cone only holds.

Regarding claim 9, the pole is a ski or a walking stick.

Regarding claim 12, the limit stop **126** disposed on the free end of the adjusting screw is a cap that is axially secured at the free end of the adjusting screw **118**' is a cap

axially secured at the free end of the adjusting screw after the radially spreadable element has been set in place.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lenhart, DE-29,706,849, in view of Neuheiten, CH-267,177, and further in view of DSI, DE-8,004,343U1.

Regarding claim 10, Lenhart discloses, in Figures 1 and 5, an adjustable-length pole comprising at least one outer tube **12**, an inner tube **11** structured, an adjusting screw **118'**, a radially spreadable element **116**, and an axially moveable interior element **117**. The inner tube **11** is dimensioned for insertion into the outer tube **12** in a telescoping fashion. A limit stop **19** is disposed at an end **13** of the inner tube **11**. The adjusting screw **118'** is axially oriented within the outer tube **12**, non-rotatable with respect to the inner tube **11**, and supported in a fixed manner on the end of the inner tube **11**. A limit stop **126** is disposed on the free end of the adjusting screw **118'**. The spreadable element **116** has a non-threaded bore **A1** (see marked-up attachment) and an inner cone **122'**. The inner cone **122'** opens towards the end of the inner tube **11**. The spreadable element **116** is disposed with its axial length between the limit stop **19** disposed at the end of the inner tube **11** and the limit stop **126** disposed on the free end of the adjusting screw **118**'. A distance **A2** between the limit stops **19**, **126** is larger than the axial length of the radially spreadable element **116** by a gap distance **A3** such that the spreadable element **116** is able to move axially within the distance between the

limit stops including the gap distance **A3**. The spreadable element **116** is able to contact the limit stop disposed on the free end of the adjusting screw **118**'. The interior element **117** has an internal threaded bore **A4** and outer cone **127'** structured, dimensioned, and disposed for cooperation with the inner cone **122'**. The interior element **117** is able to axially move with respect to the inner tube 11 by rotation thereof via the internal threaded bore **A4**. The spreadable element **116** and the interior element **117** cooperate and form a spreading device axially supported at the end of the inner tube **11**. However, Lenhart fails to disclose the inner cone **122**' being only one single inner cone of the spreadable element since the spreadable element has two inner cones, and the radially spreadable element being configured as a pot having a base penetrated by a free end area of the adjusting screw, facing away from the inner tube **11**.

Neuheiten teaches, between Figures 5 and 6, that a spreading element can have one inner cone or two inner cones as similarly taught in Lenhart. Neuheiten teaches alternative configurations in order to minimize parts. Therefore, as taught by Neuheiten, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the inner cone **122**' of Lenhart be the only one single inner cone to minimize the number of parts as an alternative configuration.

DSI teaches, in Figure 1, a radially spreadable element **10** configured as a pot having a base penetrated by a free end area of an adjusting screw **5** facing away from

the inner tube 3 as an alternative configuration for a radially spreadable element 10 with having only one single inner cone (the conical surface). Therefore, as taught by DSI, it would have been obvious to one of ordinary skill in the art at the time the invention was made to change the configuration of the spreadable element 116, as modified by Neuheiten, with that of DSI to use with the spreading element modified to have only one single inner cone.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lenhart, DE-29,706,849, in view of Neuheiten, CH-267,177, and further in view of Kupski, 3,145,669.

Regarding claim 15, Lenhart discloses, in Figures 1 and 5, an adjustable-length pole comprising at least one outer tube **12**, an inner tube **11** structured, an adjusting screw **118'**, a radially spreadable element **116**, and an axially moveable interior element **117**. The inner tube **11** is dimensioned for insertion into the outer tube **12** in a telescoping fashion. A limit stop **19** is disposed at an end **13** of the inner tube **11**. The adjusting screw **118'** is axially oriented within the outer tube **12**, non-rotatable with respect to the inner tube **11**, and supported in a fixed manner on the end of the inner tube **11**. A limit stop **126** is disposed on the free end of the adjusting screw **118'**. The spreadable element **116** has a non-threaded bore **A1** (see marked-up attachment provided in the last Office action) and an inner cone **122'**. The inner cone **122'** opens towards the end of the inner tube **11**. The spreadable element **116** is disposed with its

axial length between the limit stop **19** disposed at the end of the inner tube **11** and the limit stop **126** disposed on the free end of the adjusting screw **118**'. A distance **A2** between the limit stops **19**, **126** is larger than the axial length of the radially spreadable element **116** by a gap distance **A3** such that the spreadable element **116** is able to move axially within the distance between the limit stops including the gap distance **A3**. The interior element **117** has an internal threaded bore **A4** and outer cone **127'** structured, dimensioned, and disposed for cooperation with the inner cone **122'**. The interior element **117** is screwed onto the adjusting screw **118'** and able to axially move with respect to the inner tube 11 by rotation thereof via the internal threaded bore **A4**. The spreadable element **116** and the interior element **117** cooperate and form a spreading device axially supported at the end of the inner tube **11**. The spreading element **116** has axial slots (see Figure 6). However, Lenhart fails to disclose the inner cone **122**' being only one single inner cone of the spreadable element since spreadable element has two inner cones. Further, Lenhart fails to disclose the interior element **117** having protruding fins respectively guided in the axial slots of the spreading element **32**.

Neuheiten teaches, between Figures 5 and 6, that a spreading element can have one inner cone or two inner cones as similarly taught in Lenhart. Neuheiten teaches alternative configurations in order to minimize parts. Therefore, as taught by Neuheiten, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the inner cone **122**' of Lenhart be the only one single inner cone to minimize the number of parts as an alternative configuration.

Kupski teach, in Figure, 5, an interior element **17** having protruding fins **33** guided in axial slots **30** of a spreading element **16** to prevent the interior element from rotating relative to the spreading element. Therefore, as taught by Kupski, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a fin in the interior element of Lenhart guided in the axial slots of the spreading element of Lenhart to prevent the interior element from rotating relative to the spreading element. Given the modification, the axial slots would have had an axial length larger than an axial length of the fins.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lenhart, DE-29,706,849, in view of Neuheiten, CH-267,177, and further in view of DSI, DE-8,004,343U1, and Kupski, 3,145,669.

Regarding claim 16, Lenhart discloses, in Figures 1 and 5, an adjustable-length pole comprising at least one outer tube **12**, an inner tube **11** structured, an adjusting screw **118'**, a radially spreadable element **116**, and an axially moveable interior element **117**. The inner tube **11** is dimensioned for insertion into the outer tube **12** in a telescoping fashion. A limit stop **19** is disposed at an end **13** of the inner tube **11**. The adjusting screw **118'** is axially oriented within the outer tube **12**, non-rotatable with respect to the inner tube **11**, and supported in a fixed manner on the end of the inner tube **11**. A limit stop **126** is disposed on the free end of the adjusting screw **118'**. The

spreadable element **116** has a non-threaded bore **A1** (see marked-up attachment provided in the last Office action) and an inner cone **122'**. The inner cone **122'** opens towards the end of the inner tube **11**. The spreadable element **116** is disposed with its axial length between the limit stop **19** disposed at the end of the inner tube **11** and the limit stop **126** disposed on the free end of the adjusting screw **118**'. A distance **A2** between the limit stops **19**, **126** is larger than the axial length of the radially spreadable element **116** by a gap distance **A3** such that the spreadable element **116** is able to move axially within the distance between the limit stops including the gap distance **A3**. The interior element **117** has an internal threaded bore **A4** and outer cone **127'** structured, dimensioned, and disposed for cooperation with the inner cone **122'**. The interior element **117** is screwed onto the adjusting screw **118'** and able to axially move with respect to the inner tube 11 by rotation thereof via the internal threaded bore **A4**. The spreadable element **116** and the interior element **117** cooperate and form a spreading device axially supported at the end of the inner tube **11**. The spreading element **116** has axial slots (see Figure 6).

However, Lenhart fails to disclose the inner cone **122**' being only one single inner cone of the spreadable element since the spreadable element has two inner cones, and the radially spreadable element being configured as a pot having a base penetrated by a free end area of the adjusting screw, facing away from the inner tube **11**. Further, Lenhart fails to disclose the interior element **117** having protruding fins respectively guided in the axial slots of the spreading element **32**.

Neuheiten teaches, between Figures 5 and 6, that a spreading element can have one inner cone or two inner cones as similarly taught in Lenhart. Neuheiten teaches alternative configurations in order to minimize parts. Therefore, as taught by Neuheiten, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the inner cone **122**' of Lenhart be the only one single inner cone to minimize the number of parts as an alternative configuration.

DSI teaches, in Figure 1, a radially spreadable element **10** configured as a pot having a base penetrated by a free end area of an adjusting screw **5** facing away from the inner tube **3** as an alternative configuration for a radially spreadable element **10** with having only one single inner cone (the conical surface). Therefore, as taught by DSI, it would have been obvious to one of ordinary skill in the art at the time the invention was made to change the configuration of the spreadable element **116**, as modified by Neuheiten, with that of DSI to use with the spreading element modified to have only one single inner cone.

Kupski teach, in Figure, 5, an interior element **17** having protruding fins **33** guided in axial slots **30** of a spreading element **16** to prevent the interior element from rotating relative to the spreading element. Therefore, as taught by Kupski, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a fin in the interior element of Lenhart guided in the axial slots of the spreading

element of Lenhart to prevent the interior element from rotating relative to the spreading element. Given the modification, the axial slots would have had an axial length larger than an axial length of the fins.

Allowable Subject Matter

Claim 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st and 2nd paragraphs, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

regarding claim 11, the prior art of record does not disclose or suggest a adjustable-length pole comprising a radially spreadable element comprising a cylindrical shoulder having a smaller exterior diameter than a base of the spreadable element and facing an inner tube (lines 1-3) in combination with the spreadable element having a non-threaded bore and only a single inner cone (claim 8, lines 9-10). The closest prior art, Lindemann et al., 6,027,087, teach, in Figure 7, a shoulder 45A having a smaller exterior diameter than the base. However, the shoulder does not face the inner tube but rather the outer tube, or between the base and a top portion of the spreading element.

Response to Arguments

Applicant's arguments filed November 10, 2008 have been fully considered but they are not persuasive.

Applicant remarks that the examiner did not state a rejection for claims 10 or claim 19. In reviewing the rejections, the examiner noticed that the last 35 USC 103 rejection had a typographical error since the language in the rejection corresponded to claim 19. Further, the 35 USC 103 rejection of Lenhart, DE-29,706,849, in view of Neuheiten, CH-267,177, and further in view of DSI, DE-8,004,343U1, which discussed the spreadable element as a pot, corresponds actually to claim 10. The examiner regrets that this was not caught earlier as the claims are quite lengthy and similar in scope.

Applicant argues that submitting a declaration under rule 132 would demonstrate that the two embodiments in Figures 1 and 5 of Lenhart are unrelated and do not represent compatible teachings. In response, it should be first noted that Neuheiten is relied to teach that one can use two cones or one cone. The examiner is not relying solely on Lenhart or for that matter Lenhart's Figure 1. The declaration would possible differentiate the different operations of the two embodiment disclosed but it is the combined teaching of the combined references that would have suggested to use one cone. Is applicant showing that no one ever has made a mechanism with one cone?

The examiner differs as Neuheiten is evidence that suggests one cone versus using two cones.

Applicant further argues that the lower cone 20 in Neuheiten is a one piece unit with the actual screw 12 so it rotates when the lower tube is rotated. In response, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, it should be noted that the examiner is not relying on this particular observation but rather the teaching of making a double cone or the modification into a single cone.

Applicant further argues that the examiner has not included an identification of the differences between the prior art and the claimed invention. In response, it should be noted that the examiner has pointed out in the rejections what is missing from the primary reference thus the examiner has identified the difference between the prior primary reference. The second reference merely substantiates what is missing in the primary reference by indicating the motivation for combining the references to come out with an end result. Applicant argues that the combined references were taken without any consideration of how these pieces operate in their environment. In response, it should be noted that how the pieces operate individually is not a prerequisite for combining the references. Further, the fact that one reference operates differently from

the other reference does not obviate the fact that it is obvious to make a spreadable element with a single cone versus a double cone. The combined references result the claimed invention. If applicant is concerned in the operation of the device, then applicant is urged to apply for method claims as the patentability of the instant claims is based on the structural differences and not what the device does or operates.

Applicant further argues that the combined references present technical problems and barriers and has not teaching or direction for their assembly. In response, it should be noted that the arguments do no specify what technical problems arise. Further, there is no requirement that the examiner provide a teaching or direction for the assembly.

With respect to Mazzolla, applicant argues that the examiner looks to structures that are wholly incompatible with and inapplicable to the claimed invention and that Mazzolla is a completely different structure that has a clamping mechanism that has nothing to do with the fin and slot structure. In response, this has not been found persuasive as Mazzolla is pertinent to telescopic members, which is what the adjustable-length pole is as claimed. There is no requirement that every feature be present in the secondary reference otherwise such secondary reference would be simply used as a 35 USC 102 rejection by itself. In particular, there is no requirement that the secondary reference have a fin and slot structure. The examiner is merely utilizing the teachings of Mazzolla, which is the teaching of the notches in the outer

periphery of the spreadable element. This teaching in itself is not new to render the claims allowable. Applicant cannot merely tackle the references alone when the combined teachings would have suggested the claimed invention.

With respect to Figure 5B of the affidavit, applicant remarks that a "further limit stop (nut displayed in Figure 5B) has to be added to the screw". In response, this analysis is inaccurate as nothing has to be added because the screw already has a nut which makes up the limit stop.

Conclusion

Applicant should also note that Figure 6 in Neuheiten, CH-267177, can be modified alternatively such that the fixed taper 20 is separated and axially threaded into the threaded shank 12, as taught in DSI, or Lenhart, DE-29,706,849.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30AM-6:00PM. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/E. G./
Examiner, Art Unit 3679
December 23, 2008

/Daniel P. Stodola/
Supervisory Patent Examiner, Art Unit 3679